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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/338,729 06/23/99 GROSS

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HM12/0919

EXAMINER

BERMAN, A

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

09/19/00

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/338,729

Applicant(s)

GROSS, DENNIS

Examiner

Alysia Berman

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1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)                      18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_                      20) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-9, drawn to a composition, classified in class 424, subclass 401.

Group II. Claims 10-23, drawn to a kit comprising a first and second composition and a method of treating skin by applying the first and second compositions, classified in class 424, subclass 401.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used separately as a skin care composition and does not require the first composition for application.

3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Brenison on 12 September 2000 a provisional election was made with traverse to prosecute the invention of Group II, claims 10-23. Applicant in replying to this Office action must make affirmation of this election. Claims 1-9 are

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 10-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for alpha-hydroxy acids, beta-hydroxy acids and trichloroacetic acid, does not reasonably provide enablement for “a skin renewing acid”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The claim recites “skin renewing acid”, which is relative. The examples given in the specification of “skin renewing acid” are not exclusive. The disclosure is only enabling for alpha hydroxy acids, beta hydroxy acids and trichloroacetic acid suitable as skin renewing acids in the skin care composition.

7. Claims 10-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for sodium bicarbonate and sodium hydroxide, does not reasonably provide enablement for all alkaline agents. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification only discloses sodium bicarbonate and sodium hydroxide as suitable alkaline agents. There are numerous alkaline agents, not all of

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which are compatible with application to the skin. The disclosure is only enabling for sodium hydroxide and sodium bicarbonate as suitable alkaline agents in the skin care composition.

8. Claims 10-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for 0.1-5% of an alpha-hydroxy acid, a beta-hydroxy acid or trichloroacetic acid, does not reasonably provide enablement for an unspecified amount of these acids. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The amount of acids used in a skin care composition must be limited in order to avoid adverse and dangerous effects. The specification does not teach how one skilled in the art can make the composition using any amount of acid safely. The disclosure is only enabling for an amount of 0.1-5% of an alpha-hydroxy acid, a beta-hydroxy acid or trichloroacetic acid as safe and effective.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. The instant application is drawn to a kit comprising

a. a first composition comprising an acid

i. wherein the pH is between about 2.5 and about 4,

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- b. a second composition comprising an alkaline agent and a surfactant/emulsifying agent
- ii. wherein the pH is greater than about 7, and
- c. a means for applying the first and second compositions.

The instant application is also drawn to a method of treating skin by applying to the skin

- a. a first composition comprising an acid
    - i. wherein the pH is between about 2.5 and about 4, and
  - b. a second composition comprising an alkaline agent and at least one surfactant/emulsifying agent
    - i. wherein the pH is greater than about 7.
11. Claims 10-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,720,949 ('949).

US '949 discloses a cosmetic mask comprising a first and second composition that are applied sequentially to the face. One of the compositions comprises an acid and the other comprises an effervescent agent (abstract). The effervescent agent is preferably sodium bicarbonate and the acid is an alpha-hydroxy acid such as lactic acid (col. 2, lines 35-38). The compositions may be applied using a spatula or any other convenient application (col. 2, lines 42-47). The effervescent composition may comprise from about 1-20% of a surfactant system (col. 3, lines 31-33). Surfactants such as cetareths, ceteths, laneths, nonoxynols, octoxynols, glyceryl stearate, PEG-castor oil, poloxamers, poloxamines and steareths are disclosed at column 5, line 47 to column 6, line 35. The pH of the effervescent composition is from above 7.5 to about 9, preferably between 7.8 and 8.3 (col. 7, lines 58-60). The pH of the acid composition is

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from about 3.5 to about 6 (col. 8, lines 50-64). As a further note, pH is an inherent property of an acid or alkaline agent. Therefore, the pH of a composition comprising an acid or an alkaline agent is inherently either acidic or basic, respectively, unless specifically altered.

For additional suitable acids, see column 9, lines 8-13. See Example 1 at column 12 for one composition comprising 5.0 wt.% sodium bicarbonate, 1.5% glyceryl stearate, 5.0% cetyl alcohol, 1.5% PEG-100 stearate and 1.5% PEG-40 castor oil with a pH of 8.0 and another composition comprising 9.1% lactic acid with a pH of 4.9. The reference teaches at column 13, lines 7-9 that the composition bubbles because of the reaction between the effervescent agent and the acid, essentially neutralizing the acid.

12. The expression “comprising” permits the presence of other ingredient and does not preclude the presence of other ingredient, active or inactive, even in major amounts. *See Moleculon Research Corporation v CBS, Inc.* 229 USPQ 805, *In re Baxter* 210 USPQ 795, 803.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,720,949 ('949).

US '949 teaches all the limitations of the claims as stated above. It does not teach octoxynol-9 or polysorbate-20. However, it does teach octoxynols and polyoxyethylene fatty

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acid esters. It is within the skill in the art to use any suitable species within a disclosed genus.

Therefore, absent evidence of unexpected and superior results, the specific octoxynol and polysorbate are not considered critical.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the compositions of US '949 and substitute any suitable surfactant such as octoxynyl-9 or polysorbate-20 expecting to obtain cosmetic compositions. One would have been motivated to do so in order to obtain the emulsifying and surface-active properties exhibited by the compounds. This is a *prima facie* case of obviousness.

15. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,720,949 ('949) in view of Hawley, The Condensed Chemical Dictionary, 10<sup>th</sup> Ed., 1981.

US '949 teaches all the limitations of the claims as stated above. It does not teach polysorbate-20. Polysorbate-20 is a known surfactant/emulsifying agent as evidenced by Hawley. It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the compositions of US '949 and substitute polysorbate-20 for the surfactant expecting to obtain cosmetic compositions. One would have been motivated to do so in order to obtain the surface active and emulsifying properties of the compound. This is a *prima facie* case of obviousness.

16. Presently no claim is allowed.



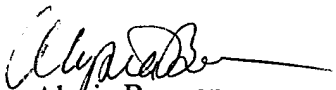
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*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703/308-4638. The examiner can normally be reached on Monday through Friday from 8:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703/308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703/305-3704 for regular communications and 703/305-3704 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-1234.

  
Alysia Berman  
Patent Examiner  
15 September, 2000

  
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